UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,261	08/05/2003	Frank P. Baldiga	RSW920030052US1	7054

70854   7590   04/28/2010

HOLMAN IP LAW/IBM RSW
175 S Main Street
Suite #850
Salt Lake City, UT 84111

EXAMINER
WHIPPLE, BRIAN P

ART UNIT	PAPER NUMBER
2452	

MAIL DATE	DELIVERY MODE
04/28/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 February 2010*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-11 and 13-21* is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-11 and 13-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All   b)☐ Some *   c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____.

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
   Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1.   Claims 1-11 and 13-21 are pending in this application and presented for examination.

Continued Examination Under 37 CFR 1.114

2.   A request for continued examination under 37 CFR 1.114 was filed in this application

after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the

appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and

the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn

pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to

37 CFR 1.114. Applicant's submission filed on 2/5/10 has been entered.

Response to Arguments

3.   Applicant's arguments with respect to claims 1-11 and 13-21 have been considered,

but are moot in view of the new grounds of rejection.

Specification

4.   The application number of the application identified in the specification is missing

([0001]). The application is assigned serial number 10/634,260, but was abandoned on 1/6/10.

Claim Objections

5.   As to claim 1, the claim prior to the current amendment used the spelling

"acknowledgment," but the newly amended text includes the spelling "acknowledgement."

The claim should be amended to use the same spelling in each instance.

6.   As to claim 15, the claim is objected to for reasons similar to claim 1 above.

Claim Rejections - 35 USC § 112

7.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming
> the subject matter which the applicant regards as his invention.

8.   Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for

failing to particularly point out and distinctly claim the subject matter which applicant

regards as the invention.

9.   As to claim 13, the claim is dependent upon cancelled claim 12. Applicant may have

intended to change the dependency to claim 10. Appropriate correction is required.

Claim Rejections - 35 USC § 101

10.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

11.   Claims 15-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

12.   As to claim 15, the claimed system may be interpreted as software per se ([0044], ln. 1-2 of the specification). Software fails to fall into one of the four statutory classes of invention: process, machine, manufacture, or composition of matter.

13.   As to claims 16-17, the claims are rejected due to their dependency on, and inclusion of, the rejected subject matter of claim 15 above.

14.   As to claim 18, the claimed program product is not adequately described as to eliminate transitory, non-statutory, embodiments. The applicant is advised that recent Office guidelines suggest adding the term "non-transitory" to overcome such rejections.

15.   As to claims 19-20, the claims are rejected due to their dependency on, and inclusion of, the rejected subject matter of claim 18 above.

Claim Rejections - 35 USC § 103

16.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art
> are such that the subject matter as a whole would have been obvious at the time the invention was made to a
> person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be
> negatived by the manner in which the invention was made.

17.   Claims 1-3, 5-6, 9-11, and 14-21 rejected under 35 U.S.C. 103(a) as being unpatentable

over Nazari, U.S. Patent No. 6,842,789 B1, in view of Okano et al. (Okano), U.S. Publication

No. 2002/0062485 A1.

18.   As to claim 1, Nazari discloses a method for assigning a device identifier to a device

(Abstract, ln. 1-4), the method comprising:

        receiving a request at a server from the device for the device identifier (Col. 3, ln. 32-

38; Col. 5, ln. 48-53);

        obtaining the device identifier (Col. 5, ln. 54-60), the device identifier being unique

from device identifiers of other devices identified by the server (Abstract, ln. 1-4, "wherein

the identifier is unique across the distributed computing system") and distinct from a

network address of the device (Fig. 2; Col. 4, ln. 18-37);

sending the device identifier to the device (Col. 5, ln. 63 – Col. 6, ln. 4); and

marking the status of the device identifier as in use after receiving an

acknowledgment from the device (Col. 5, ln. 63 – Col. 6, ln. 9).

Nazari is silent on the request is accompanied by correlation data with unique

identification information associated with the device;

the device identifier is obtained at the server and associated by the server with

correlation data from the device in response to the request from the device;

marking a status of the device identifier as pending;

the device identifier is accompanied by the correlation data associated with the

device;

the acknowledgement is accompanied by the correlation data associated with the

device; and

sending a confirmation to the device after the acknowledgment is received, wherein

the confirmation is accompanied by the correlation data associated with the device.

However, Okano discloses the request is accompanied by correlation data with

unique identification information associated with the device ([0020], ln 1-4; [0084] – [0085];

[0195] – [0196]; DHCP communications must be accompanied by the MAC address of the

requesting device, as otherwise communication would not be possible, given that the device

is in the process of obtaining a network address);

the device identifier is obtained at the server and associated by the server with

correlation data from the device in response to the request from the device ([0092]; [0195] –

[0196]);

marking a status of the device identifier as pending ([0092]; the IP addresses are set as

temporarily allocated, which is marking the device identifiers as pending);

the device identifier is accompanied by the correlation data associated with the device

([0098]; DHCP communications must be accompanied by the MAC address of the requesting

device, as otherwise communication would not be possible, given that the device is in the

process of obtaining a network address);

the acknowledgement is accompanied by the correlation data associated with the

device ([0100] – [0101]; DHCP communications must be accompanied by the MAC address

of the requesting device, as otherwise communication would not be possible, given that the

device is in the process of obtaining a network address); and

sending a confirmation to the device after the acknowledgment is received ([0102];

[0105]; [0110]), wherein the confirmation is accompanied by the correlation data associated

with the device ([0102]; [0105]; [0110]; DHCP communications must be accompanied by the

MAC address of the requesting device, as otherwise communication would not be possible,

given that the device is in the process of obtaining a network address).

It would have been obvious to one of ordinary skill in the art at the time of the

invention to modify the teachings of Nazari in the aforementioned manner as taught by

Okano in order to identify a properly device with correlation data prior to device identifier

assignment and in order to send communications back and forth in response to each step of

device identifier assignment so as to ensure each step is approved and the communication

partner is informed of the successful approval/completion of each step.

19.   As to claim 2, Nazari and Okano disclose the invention substantially as in parent

claim 1, further comprising:

receiving a second acknowledgment from the device (Okano: [0110]-[0111]; [0149]-

[0151]; it is inherent in and a standard feature of DHCP, which is taught by Okano, that a

second acknowledgement is sent from a device to renew its lease); and

sending a second confirmation to the device (Okano: [0102]; [0110]-[0111]; [0147]-

[0151]; it is inherent in and a standard feature of DHCP, which is taught by Okano, that a

server sends a confirmation to renewal requests in the form of a DHCPACK message to

extend a device's lease).

20.   As to claim 3, Nazari and Okano disclose the invention substantially as in parent

claim 1, further comprising managing a set of device entries at the server (Nazari: Col. 3, ln.

32-38; Col. 5, ln. 26-29 and 54-60), wherein each of the device entries comprises a unique

device identifier (Nazari: Abstract, ln. 1-4), a status indicator to indicate a status of the

corresponding device identifier (Okano: [0092]; [0135]; [0179] – [0180]; [0195] – [0197]), and

correlation data associated with the corresponding device identifier (Okano: [0092]; [0195] –

[0196]).

21.   As to claim 5, Nazari and Okano disclose the invention substantially as in parent

claim 3, wherein each of the device entries further includes a timestamp, the method further

comprising setting the timestamp when the status is marked as pending (Okano: [0092];

temporarily allocated IP addresses are made and lease times are set, which is setting a

timestamp when the status is marked as pending).

22.   As to claim 6, Nazari and Okano disclose the invention substantially as in parent

claim 1, wherein obtaining the device identifier comprises:

        generating the device identifier before the request from the device is received at the

server (Nazari: Col. 5, ln. 54-60; the global pool of instance numbers is present before the

request is received);

        marking the status of the device identifier as unused (Nazari: Col. 5, ln. 54-60; the

global pool consists of unused and available instance numbers); and

locating the device identifier having the status marked as unused after the request is

received (Nazari: Col. 5, ln. 54-60; the provisional instance number may be identified as

available, that is unused, in the global pool of instance numbers).

23.   As to claim 9, Nazari and Okano disclose the invention substantially as in parent

claim 1, further comprising:

reusing the device identifier for another request received from another device after a time

out period has elapsed (Okano: [0200]); and

        sending a rejection to the device if the acknowledgment is received after the time out

period has elapsed (Okano: [0200]; the timed out subscriber terminal is disabled to use the IP

address, which is a rejection).

24.   As to claim 21, the claim is rejected for reasons similar to claim 6 above.

25.   As to claim 10, the claim is rejected for reasons similar to claim 1 above.

26.   As to claim 11, the claim is rejected for reasons similar to claim 5 above.

27.   As to claim 14, Nazari and Okano disclose the invention substantially as in parent

claim 10, further comprising sending a second acknowledgment to the server if the

confirmation has not been received after a time out period (Okano: Abstract; it is inherent in

and a standard feature of DHCP, which is taught by Okano, that a second acknowledgement

is sent to the server after a time out period).

28.   As to claims 15-16, the claims are rejected for reasons similar to claim 1 above.

29.   As to claim 17, the claim is rejected for reasons similar to claim 3 above.

30.   As to claims 18-19, the claims are rejected for reasons similar to claim 1 above.

31.   As to claim 20, the claim is rejected for reasons similar to claim 9 above.

32.   Claims 4, 7, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Nazari and Okano as applied to claims 1-3, 5-6, 9-11, and 14-21 above, and further in view of

Matsuda et al. (Matsuda), U.S. Publication No. 2002/0133573 A1.

33.   As to claim 4, Nazari and Okano disclose the invention substantially as in parent

claim 3, wherein the correlation data comprises:

device data to particularly identify the corresponding device (Okano: [0092]; [0195] –

[0196]; the MAC address identifies a corresponding device).

Nazari and Okano are silent on user data to identify a particular user of the

corresponding device.

However, Matsuda discloses user data to identify a particular user of the

corresponding device ([0065], ln. 5-7; [0066], ln. 1-4; [0115]).

It would have been obvious to one of ordinary skill in the art at the time of the

invention to modify the teachings of Nazari and Okano in the aforementioned manner as

taught by Matsuda in order to identify a user and ensure access is granted before allowing

changes to be made to the system (Matsuda: [0115]).

34.   As to claim 7, Nazari and Okano disclose the invention substantially as in parent

claim 1, but are silent on obtaining the device identifier comprises generating the device

identifier after receiving the request.

However, Matsuda discloses obtaining the device identifier comprises generating the

device identifier after receiving the request (Fig. 7, items 704, 706, and 708; [0065]; a device

identifier is generated using the MAC address, desired IP address, and desired host name in

the request, which is correlation data in the request).

It would have been obvious to one of ordinary skill in the art at the time of the

invention to modify the teachings of Nazari and Okano in the aforementioned manner as

taught by Matsuda in order to allow a client to suggest desired settings in a request (Matsuda:

[0065], ln. 5-7).

35.   As to claim 13, the claim is rejected for reasons similar to claim 4 above.

36.   Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nazari and

Okano as applied to claims 1-3, 5-6, 9-11, and 14-21 above, and further in view of Meier,

U.S. Patent No. 7,096,273 B1.

37.   As to claim 8, Nazari and Okano disclose the invention substantially as in parent

claim 1, but are silent on marking the status of the device identifier as unused if the

acknowledgment is not received after a time out period.

However, Meier discloses marking the status of the device identifier as unused if the

acknowledgment is not received after a time out period (Col. 2, ln. 8-15).

It would have been obvious to one of ordinary skill in the art at the time of the

invention to modify the teachings of Nazari and Okano by marking a device identifier as

unused if an acknowledgement is not received after a time out period as taught by Meier in

order to put the device identifier back into a pool ready to be re-used (Meier, Col. 2, ln. 13-

15).

Conclusion

38.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure. See the Notice of References Cited (PTO-892).

39.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to BRIAN P. WHIPPLE whose telephone number is (571)270-

1244. The examiner can normally be reached on Mon-Fri (8:30 AM to 5:00 PM EST).

        If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Thu Nguyen can be reached on 571-272-6967. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published

applications may be obtained from either Private PAIR or Public PAIR. Status information

for unpublished applications is available through Private PAIR only. For more information

about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access

to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197

(toll-free). If you would like assistance from a USPTO Customer Service Representative or

access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or

571-272-1000.

Brian P. Whipple
/B. P. W./
Examiner, Art Unit 2452
4/17/10

/THU NGUYEN/
Supervisory Patent Examiner, Art Unit 2452